Appl. No.: 10/670,771 Amdt. dated June 20, 2006

Reply to Office Action of February 27, 2006

#### REMARKS

The following arguments and the accompanying affidavit of Richard D. Guarino, Bryce N. Chaney, Andrea Liebmann-Vinson, Perry D. Haaland, and Mohammad A. Heidaran were not presented earlier as Applicants earnestly believed that the previously presented claims recited patentable subject matter. Pursuant to 37 C.F.R. § 1.116 and the *Manual of Patent Examining Procedure* (MPEP), any affidavits and other evidence that will place the application in condition for allowance may be entered after final rejection (MPEP § 714.12). Applicants believe that the following arguments and the accompanying affidavit overcome the Examiner's rejection of pending claims 30, 31, 38, and 65-85, and that these claims are in condition for allowance. Accordingly, the Examiner is respectfully requested to enter this affidavit into the record to further prosecution or to place the application in better condition for appeal.

The Examiner's comments in the Office Action are addressed below in the order set forth therein.

### The Rejection of the Claims Under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 30, 31, 38, and 65-85 have been rejected under 35 U.S.C. § 103(a) on the grounds that they are unpatentable over Campbell *et al.* (U.S. Patent Application Publication No. 20030162289) in view of Glass *et al.* (*Biomaterials*, 17:1101-08, 1996). This rejection is respectfully traversed.

Pursuant to the guidelines set forth in the MPEP, "subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103" (§ 2141.01, citing *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter., 1981)). Applicants respectfully submit that the Campbell *et al.* published application has been improperly cited in the present rejection under 35 U.S.C. § 103(a). Specifically, the Campbell *et al.* published application does not constitute 102(a) prior art against pending claims 65, 66, 69, 70-78, 80, and 82-85, which claim subject matter added when the present continuation-in-part application was filed on September 26, 2003. As set forth in the accompanying affidavit of Richard D. Guarino, Bryce N. Chaney, Andrea Liebmann-Vinson, Perry D. Haaland, and Mohammad A. Heidaran, the subject matter claimed in pending claims 65, 66, 69, 70-78, 80, and 82-85 was conceived of and reduced to

Appl. No.: 10/670,771 Amdt. dated June 20, 2006 Reply to Office Action of February 27, 2006

practice in the U.S. prior to August 28, 2003 (the publication date of the Campbell *et al.* published application).

Furthermore, the Campbell *et al.* published application does not constitute 102(e) prior art against any of the pending claims in the present application (*i.e.*, claims 30, 31, 38, and 65-85). This is because the Campbell *et al.* published application was filed *prior* to the filing date of the present application but published *after* the date for which the subject matter claimed in pending claims 65, 66, 69, 70-78, 80, and 82-85 was conceived of and reduced to practice, and the earliest priority date claimed in the application (*i.e.*, August 15, 2003), which applies to pending claims 30, 31, 38, 67, 68, 79, and 81. The subject matter of the Campbell *et al.* published application and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Copies of the assignments to Becton, Dickinson, and Company that were recorded with the USPTO are submitted herewith in **Appendix A** as evidence of common ownership. Under 35 U.S.C. § 103(c), such commonly owned 102(e) prior art cannot be used to preclude patentability under 35 U.S.C. § 103(a).

In conclusion, Applicants respectfully submit that consideration of the Campbell *et al.* published application with respect to an obviousness inquiry is improper. Applicants respectfully ask that this rejection be withdrawn.

Appl. No.: 10/670,771 Amdt. dated June 20, 2006 Reply to Office Action of February 27, 2006

#### **CONCLUSION**

In view of the foregoing arguments, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) has been obviated and the claims are in condition for allowance. Early notice to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject Application, the Examiner is invited to call the undersigned attorney.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

David E. Cash

Registration No. 52,706

Customer No. 47656 ALSTON & BIRD LLP Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Raleigh Office (919) 862-2200 Fax Raleigh Office (919) 862-2260 **CERTIFICATE OF MAILING** 

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 20,

Lynda ilo Pixley

4 of 4

# APPENDIX A

Attorney Docket No. 035510/296072(P-5840-P1)

Appl. No. 10/670,771

Filing Date: September 26, 2003



JUN 2 2 2006

DRP.5277

MAY 09, 2002

BECTON, DICKINSON AND COMPANY DAVID W. HIGHET INTELLECTUAL PROPERTY DEPARTMENT 1 BECTON DRIVE - MAIL CODE: 089 FRANKLIN LAKES, NJ 07417-1880 Under Secretary of Commerce For Intellectual Property and Director of the United States Patent and Trademark Office Washington, DC 20231 www.uspto.gov



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RECORDATION DATE: 03/06/2002

REEL/FRAME: 012673/0395

NUMBER OF PAGES: 8

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

HEIDARAN, MOHAMMAD

DOC DATE: 11/12/2001

ASSIGNOR:

CAMPBELL, ROBERT L.

DOC DATE: 11/12/2001

ASSIGNOR:

SPARGO, CATHERINE A.

DOC DATE: 11/12/2001

ASSIGNOR:

WILKINS, JAMIE H.

DOC DATE: 11/12/2001

ASSIGNOR:

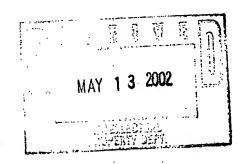
HAALAND, PERRY D.

DOC DATE: 11/15/2001

ASSIGNEE:

BECTON, DICKINSON AND COMPANY INTELLECTUAL PROPERTY DEPARTMENT 1 BECTON DRIVE, MAIL CODE: 089 FRANKLIN LAKES, NEW JERSEY

07417-1880



012673/0395 PAGE 2

SERIAL NUMBER: 09992124

PATENT NUMBER:

FILING DATE: 11/19/2001 ISSUE DATE:

VIOLET MCCOY, EXAMINER ASSIGNMENT DIVISION OFFICE OF PUBLIC RECORDS 03-19-2002 NN 22 10116 E

(Rev. 6-93) OMB No. 0651-0011 (exp. 4/94)	U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office		
To the Honorable Comercial atents and Trademarks: Please record the authority of copy thereof.			
Name of conveying party(ies):  Mohammad Heidaran, Robert L. Campbell, Catherine A. Spargo, Jamie H. Wilkins and Perry D. Haaland	Name and address of receiving party(ies):     Name: BECTON, DICKINSON AND COMPANY		
Additional name(s) of conveying party(ies) attached?   Yes  No  Nature of conveyance:	Internal Address: Intellectual Property Department Mail Code: 089		
X Assignment	Street Address: 1 Becton Drive  City: Franklin Lakes State: NJ ZIP: 07417-1880		
Other:  Execution Date: November 12, 2002 and November 15, 2002	Additional name(s) & address(es) attached?		
4. Application number(s) or patent number(s):  If this document is being filed together with a new application, to A. Patent Application No.(s) 09/992,124	B. Patent No.(s) MAR - 6 2002		
5. Name and address of party to whom correspondence concerning document should be mailed:	ched? ☐ Yes ☒ No  6. Total number of applications and patents involved: 1		
Name: BECTON, DICKINSON AND COMPANY  Internal Address: Intellectual Property Department Mail Code: 089	7. Total fee (37 CFR §3.41): ☐ Enclosed ☒ Authorized to be charged to deposit account		
Street Address: 1 Becton Drive  City: Franklin Lakes State: NJ ZIP: 07417-1880	8. Deposit account number: 02-1666		
DO NOT USE	THIS SPACE		
9. Statement and signature. To the best of my knowledge and belief, the foregoing information is t document.	true and correct and any attached copy is a true copy of the original		
David W. Highet, Reg. No. 30, 265  Name of Person Signing  /19/2002 GTON11 00000059 021666 09992124	Signature Date		
FC:581 40.00 CH Total number of pages	including cover sheet, attachments and document: 8		

Mail documents to be recorded with required cover sheet information to: Commissioner of Patents & Trademarks, Box Assignments Washington, D.C. 20231

FORM PTO-1595

## **ASSIGNMENT**

Serial No.: Filed:

WHEREAS, and Robert L. Campbell, residing at 607 Phar Lap Lane, Bahama, North Carolina 27503; Mohammad Heidaran, residing at 207 Painted Fall Way, Cary, North Carolina 27513; Catherine A. Spargo, residing at 7103 Eastridge Drive, Apex, North Carolina 27502; Jamie H. Wilkins, residing at 9 Pedestal Rock Lane, Durham, North Carolina 27712; and Perry D. Haaland, residing at 8914 Laurel Springs Drive, Chapel Hill, North Carolina 27516, all citizens of the United States of America (hereinafter called "Assignors"), have made certain new and useful inventions or discoveries relating to:

## PEPTIDES PROMOTING CELL ADHERENCE, GROWTH AND SECRETION

for which they have executed a Declaration for an application for Letters Patent of the United States of America; and

WHEREAS, BECTON, DICKINSON AND COMPANY, a corporation of New Jersey, (hereinafter called "Assignee"), is desirous of acquiring the entire right, title and interest therein.

NOW, THEREFORE, BE IT KNOWN that for and in consideration of the premises and in acknowledgment, confirmation and performance of obligations which arose out of the terms and conditions of Assignors' employment by Assignee at the time the invention was made, and other valuable considerations to them, the receipt and sufficiency of which are hereby acknowledged, Assignors have assigned, and transferred, and do hereby assign, and transfer unto said Assignee the entire right, title, and interest in and to all said inventions and discoveries disclosed in said application, whose identification above by serial number and filing date, when available, is hereby authorized, and in and to said application, all substitutions, divisions and continuations or continuations-in-part, thereof, and in and to all Letters Patents, United States and foreign, that may be granted for said inventions and discoveries, and in and to all extensions, renewals and reissues thereof, the same to be held and enjoyed by said Assignee, its successors and assigns, as fully and entirely as the same would have been held and enjoyed by Assignors if this Assignment and sale had not been made; and

Assignors hereby authorize and request the Commissioner of Patents and Trademarks of the United States to issue said Letters Patent in accordance with this Agreement; and

For the consideration aforesaid, Assignors covenant and agree with said Assignee that they have a full and unencumbered title to the inventions and discoveries above described and hereby assigned, which title they warrant unto said Assignee, its successors and assigns; and

For the consideration aforesaid, Assignors further covenant and agree that they will, whenever requested, but without cost to them promptly communicate to said Assignee or its representatives any facts known to them relating to said inventions and discoveries, testify in any interference or legal proceedings involving said inventions and discoveries, and execute any additional papers that may be necessary to enable said Assignee or its representatives, successors, nominees, or assigns to secure full and complete protection of the inventions and discoveries or that may be necessary to vest in Assignee the complete title to the inventions and discoveries and patents hereby conveyed and to enable it to record title.

Robert L. Campbell

DATE: 1/12/01

STATE OF Morth Carolina ) COUNTY OF Durham )

BE IT REMEMBERED, that on this /2 day of November 2001, before me, a Notary Public, personally appeared Robert L. Campbell, who I am satisfied is the person named in and who executed the foregoing instrument in my presence, I and having first made known to him the contents thereof, he did acknowledge that he signed, sealed, and delivered the same as his voluntary act and deed for the uses and purposes therein expressed.

Notary Public
My Commission Expires: 4-21-2002

DATE: 11/12/01

STATE OF Morch Carolina) COUNTY OF Durham

BE IT REMEMBERED, that on this \_/2 day of Movember 2001, before me, a Notary Public, personally appeared Mohammad Heidaran, who I am satisfied is the person named in and who executed the foregoing instrument in my presence, I and having first made known to him the contents thereof, he did acknowledge that he signed, sealed, and delivered the same as his voluntary act and deed for the uses and purposes therein expressed.

Sinda W. Jingen Notary Public My Commission Expires: 4-21-2002

Catherine A. Spargo

STATE OF Morth Carolina)
COUNTY OF Durham

BE IT REMEMBERED, that on this \_\_/2\_\_\_\_ day of November. 2001, before me, a Notary Public, personally appeared Catherine A. Spargo, who I am satisfied is the person named in and who executed the foregoing instrument in my presence, I and having first made known to her the contents thereof, she did acknowledge that she signed, sealed, and delivered the same as her voluntary act and deed for the uses and purposes therein expressed.

Synda W. Jungen Notary Public My Commission Expires: 4-21-2002

Jamie H. Wilkins

DATE: November 12, 2001

STATE OF Morth Carolina)
COUNTY OF Durham

BE IT REMEMBERED, that on this \_/2 day of Movember, 2001, before me, a Notary Public, personally appeared Jamie H. Wilkins, who I am satisfied is the person named in and who executed the foregoing instrument in my presence, I and having first made known to him the contents thereof, he did acknowledge that he signed, sealed, and delivered the same as his voluntary act and deed for the uses and purposes therein expressed.

Synda W. Jingen
Notary Public
My Commission Expires: 4-21-2002

Perry D. Howland
Perry D. Haaland

DATE: Nov 15, 2001

STATE OF North Carolina

COUNTY OF Johnston

Betty O. Stewar

Notary Public

My Commission Expires: 12-6-2002

Doc. No. 43669

OPK/ASSIGNMENTS

4/21/04 10:24 PAGE 2/4 RightFAX





UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231

P. 5840P1



\* 700078283A\*

APRIL 21, 2004

DAVID W. HIGHET CHIEF INTELLECTUAL PROPERTY COUNSEL 1 BECTON DRIVE, MC 089 FRANKLIN LAKES, NJ 07417

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RECORDATION DATE: 04/14/2004

REEL/FRAME: 014516/0983

NUMBER OF PAGES: 7

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

GUARINO, RICHARD DAVID

DOC DATE: 04/02/2004

ASSIGNOR:

CHANEY, BRYCE NELSON

DOC DATE: 04/05/2004

ASSIGNOR:

LIEBMANN-VINSON, ANDREA

DOC DATE: 04/05/2004

ASSIGNOR:

HAALAND, PERRY D.

DOC DATE: 04/05/2004

ASSIGNOR:

HEIDARAN, MOHAMMAD A.

DOC DATE: 04/02/2004

01451.6/0983 PAGE 2

ASSIGNEE:

BECTON, DICKINSON AND COMPANY 1 BECTON DRIVE FRANKLIN LAKES, NEW JERSEY 07417

SERIAL NUMBER: 10670771

PATENT NUMBER:

FILING DATE: 09/26/2003

ISSUE DATE:

SHAREILL COLES, EXAMINER ASSIGNMENT DIVISION OFFICE OF PUBLIC RECORDS

JUN 2 2 2006

P-5840P1

RECORDATION FORM COVER SHEET  NO. 0651-0027 (exp. 6/30/2005)  RECORDATION FORM COVER SHEET  U.S. DEPARTMENT OF COMMERCE  U.S. Patent and Trademark Office		
Tab settings ⇔⇔⇔ ▼ ▼	Y Y Y	
To the Honorable Commissioner of Patents and Trademarks: I	Please record the attached original documents or copy thereof.	
Name of conveying party(les):     Richard David Guarino; Bryce Nelson Chaney;     Andrea Liebmann-Vinson; Perry D. Haaland;     and Mohammad A. Heidaran	Name and address of receiving party(ies)     Name: Becton, Dickinson and Company     Internal Address:	
Additional name(s) of conveying party(les) attached? Yes V		
3. Nature of conveyance:  Assignment Merger  Security Agreement Change of Name	Street Address: 1 Becton Drive	
April 2 and April 5, 2004  Execution Date:	City: Franklin Lakes State: NJ Zip: 07417  Additional name(s) & address(es) attached? Yes No	
4. Application number(s) or patent number(s):		
A. Patent Application No.(s) 10/670,771	B. Patent No.(s)	
	ached? Yes No	
Name and address of party to whom correspondence concerning document should be mailed:     Name: David W. Highet	7. Total fee (37 CFR 3.41)\$ 40.00	
Chief Intellectual Property Counsel Internal Address:	Enclosed  Authorized to be charged to deposit account	
Street Address: 1 Becton Drive, MC 089	8. Deposit account number:  02-1666	
City: Franklin Lakes State: NJ Zip: 07417		
DO NOT USE THIS SPACE		
9. Signature.  Jaconda Wagner, Reg. No. 33,310  Name of Person Signing  Total number of pages including covered to the control of pages including the	Note Proposed Signature Date per sheet, attachments, and documents: 7	

# ASSIGNMENT OF APPLICATION FOR UNITED STATES PATENT

WHEREAS, Richard David Guarino, Bryce Nelson Chaney, Andrea Liebmann-Vinson, Perry D. Haaland and Mohammad A. Heidaran hereinafter (collectively) referred to as the assignor, have invented a certain improvement relating to PEPTIDES FOR ENHANCED CELL ATTACHMENT AND GROWTH, for which said assignor has caused an application for a United States Patent to be prepared,

[ ] the inventor's declaration for said application being executed concurrently with the execution of this instrument; said
application to be filed in the U.S. Patent and Trademark Office;
[X] said application having been filed in the U.S. Patent and Trademark Office on September 26, 2004, and given
Application No. 10/670,771;
[ ] said application having been filed under the Patent Cooperation Treaty on, and given the title of
the United States of America having been designated.

AND WHEREAS Becton Dickinson and Company, having an address at Mail Code 089, 1 Becton Drive, Franklin Lakes, New Jersey 07417-1880, hereinafter referred to as the assignee, is desirous of acquiring the entire right, title and interest in and to said application, including any divisions and continuations thereof, and in and to said invention and any patents which may be granted therefor, including any renewals, reissues and prolongations thereof;

NOW THIS WITNESSETH, for good and valuable consideration paid by said assignee to said assigner, the receipt and sufficiency of which is hereby acknowledged, said assignor hereby assigns, sells and transfers to said assignee, and said assignee's successors and assigns, the entire and exclusive right, title and interest in and to said invention and to said application, including any divisions and continuations thereof, and in any patents which may be granted therefor, including any renewals, reissues and prolongations thereof; said assignee, and said assignee's successors and assigns, to have, hold, exercise and enjoy the said invention and said application, including any divisions and continuations thereof, and any patents which may be granted therefor, including any renewals, reissues and prolongations thereof, with all the rights, powers, privileges and advantages in anywise arising from or appertaining thereto, for and during the term or terms of any such patents when granted, including any renewals, reissues and prolongations thereof, for the use and benefit of said assignee, and said assignee's successors and assigns, in as ample and beneficial a manner as the said assignor might or could have held and enjoyed the same, if this assignment had not been made;

AND said assignor hereby agrees to perform, upon the request of said assignee, or said assignee's successors or assigns, any acts relating to the obtaining or to the asserting of said patents, including any renewals, reissues, and prolongations thereof;

AND said assignor authorizes and requests the Commissioner of Patents and Trademarks to issue a Patent on said application, and on any divisions and continuations thereof, to said assignee, and said assignee's successors and assigns, in accordance herewith.

Signature: Ryland David Dr	ann	Date: 09/02/04
First Inventor: RICHARD DAVID GUARINO		
Citizenship: U.S.		N 05540
Residence and Post Office Address: 509 Sturminster Dri	ve, Holly Springs, North Caro	mna 25/40
State of Worth Carolina  County of WAKE SS:  Before me personally appeared said RICHARD DAVID GUARING  2 day of April 2004  Seal  My Commission Expires: Wovember 16, 200	Notary Public	instrument to be his free act and deed this

Date: 4/5/04
" (
N. A. W. ARROR
m, North Carolina 27707
ed the foregoing instrument to be his free act and deed this
ublic

Signature:	Date: 4-5-04
Third Inventor: ANDREA LIEBMANN-VINSON	
Citizenship: Germany	
Residence and Post Office Address: 611 November Court, Willo	w Springs, North Carolina 27592
State of North Cardina ) County of WAKE SS:	
Before me personally appeared said ANDREA LIEBMANN-VINSO this	N, and acknowledged the foregoing instrument to be his free act and deed
Seal  My Commission Expires: November 16, 2008	Notary Public
Colless (C)	

## ASSIGNMENT OF APPLICATION FOR UNITED STATES PATENT

Signature:	Tern D.	Hanland		Date: 4-05-04
Fourth Inventor	: PERRYD. HAAI	LAND		•
Citizenship: U.S	S.			
Residence and I	Post Office Address:	8914 Laurel Springs Driv	e, Chapel Hill, North Carolina 27	516
State of No	orth Cardina)			
County of	WAKE			<u></u>
Before me person	ally appeared said PE	RRY D. HAALAND, and a	knowledged the foregoing instrument	to be his free act and deed this
day of Apri	1,2004	·	Opla	
Seal	7.1		Notary Public	
My Commission	Expires: <u>Novemb</u>	ber 16,2008		

-5-

Signature:	Date: 4/2/04
Fifth Inventor: MOHAMMAD A. HEIDARAN	
Citizenship: U.S.	
Residence and Post Office Address: 207 Painted Fall Way, Cary, No	rth Carolina 27513
•	
State of Nov H. Carolina	
County of WAKE SS:	
Before me personally appeared said MOHAMMAD A. HEIDARAN, and this 2 day of April, 2004	d acknowledged the foregoing instrument to be his free act and deed
Seal —	(C) flum
My Gonthission Expires: Movember 16, 2008	Notary Public
The second secon	
John Crimin Miller &	